

REMARKS

Amendments to claims 30, 40, 42, 49, and 53 are for the purpose of clarifying what Applicants regard as the invention. Support for new claims 55 and 56 can be found at least in figures 7, 9, and 10 of the application. No new matter has been added.

I. Claim rejection under § 112

Claims 29-32, 34, 35, 38-45, 48, 49, and 52-54 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 48 has been canceled. Claims 40, 42, and 53 have been amended to remove the alleged deficiencies. According to the Office Action, claims 30 and 53 allegedly omit the essential element “an optical imaging apparatus.” However, Applicants respectfully note that the specification does not describe such element to be essential (See MPEP § 2172.01 - which states that a rejection under § 112 is proper when “a claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record.”). Further, as described in pages 16-17 and figures 7, 9, and 10 of the specification, an embodiment may include just the marker (without the optical apparatus). For at least the foregoing reasons, Applicants respectfully request that the § 112 rejection for claims 30 and 53, and their respective dependent claims, be withdrawn.

Claims 30-32, 48, 49, and 52 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable simultaneous detection of two locations by an imaging apparatus. Applicants respectfully direct the Examiner’s attention to figure 4 of the application, which shows the markers 406 being simultaneously detected by an imaging apparatus 408.

II. Claim rejection under § 103

Claims 29-31, 34, 35, 38-45, 49, and 52-54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Josefsson in view of U.S. Patent No. 6,061,644 (Leis).

Claim 30 recites a marker block and two reference locations on its surface area. Claim 53 recites a marker block and two reflective elements located on its surface. Neither Josefsson

nor Leis discloses or suggests the above limitations. Josefsson discloses attaching individual retro-reflective materials directly to a patient's body (see page 121, bottom of right column, and figures C and E on page 127), and therefore, does not disclose or suggest a marker block having two reference locations or two reflective elements on its surface. According to the Office Action, Josefsson allegedly inherently discloses the above limitations. Applicant respectfully disagrees. As discussed, Josefsson discloses attaching individual retro-reflective materials to a patient's body. Because in Josefsson, the retro-reflective materials are structurally independent from each other, Josefsson in fact teaches away from a common structure (i.e., a marker block) that is used to carry two or more reflective elements.

Leis also does not disclose or suggest the above limitation, and therefore fails to make up the deficiency present in Josefsson. Rather, Leis discloses surgical instruments 11a, 11b, each of which includes a plurality of markers 12 (column 3, lines 58-60). The surgical instruments 11a, 11b are for performing surgeries on a patient, and therefore are not marker blocks, which do not and cannot be used to perform surgeries. Since neither Josefsson nor Leis discloses or suggests the above limitation, they cannot be combined to form the resulting subject matter of claims 30 and 53. For at least the foregoing reason, claims 30 and 53, and their respective dependent claims, are believed allowable over Josefsson, Leis, and their combination.

III. Claim rejection under § 101

Claim 49 stand rejected under 35 U.S.C. § 101. Claim 49 has been amended per the Examiner's recommendation.

IV. Claims 57-64

New claim 57 recites coupling a first marker to a first portion of a person, and coupling a second marker to a second portion of the person, wherein the first marker remains substantially stationary relative to the second marker during the procedure. Applicant respectfully submits that claim 57 and its dependent claims are allowable over Josefsson and Leis since neither reference discloses or suggests the above limitations. In particular, Leis discloses securing markers to a surgical instrument, and therefore, does not disclose or suggest coupling markers to

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a person. In addition, Josefsson discloses placing markers on different body parts that moves relative to each other during a procedure (i.e., so that an animation can be created). As such, Josefsson in fact teaches away from markers that remain substantially stationary relative to each other during a procedure.

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CONCLUSION

If the Examiner has any questions or comments regarding this response, please contact the undersigned at the number listed below.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Bingham McCutchen's Deposit Account No. **50-2518**, referencing billing number **7010755001**. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Bingham McCutchen's Deposit Account No. **50-2518**, referencing billing number **7010755001**.

Respectfully submitted,
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